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Express Mail No. EV 346 811 US

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Andrew DOWNIE et al.

Confirmation No.: 6184

Application No.: 10/798,201

Group Art Unit: 3672

Filing Date: March 10, 2004

For: DOWNHOLE TOOL

Attorney Docket No.: 85170-4599

**PETITION FOR RETROACTIVE FOREIGN FILING LICENSE  
UNDER 37 C.F.R. § 5.25 and § 5.13**Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This petition is being filed to request a retroactive foreign filing license for U.K. Application No. GB 0101014.9, filed January 15, 2001 in the United Kingdom; and PCT Application No. PCT/GB02/00178, filed January 15, 2002 and designating all Contracting States bound by the Patent Cooperation Treaty. Both applications were entitled "IMPROVED DOWNHOLE TOOL."

The U.K. Application No. GB 0101014.9 and PCT Application No. PCT/GB02/00178 named the following one U.S. resident as inventor:

**Roy POWELL**, 269 Solomon Drive, Estates Park, CO 85017.

The corresponding U.S. Application for these U.K. and PCT applications is U.S. Application No. 10/798,201, filed March 10, 2004 and entitled "DOWNHOLE TOOL." Named as inventors in this U.S. Application are: Andrew McPherson DOWNIE; Edward Docherty SCOTT; and Roy POWELL.

Also submitted herewith is a verified statement (declaration) prepared in accordance with 37 C.F.R. § 5.25(a)(3).

The fee for this petition is believed to be \$130. Please charge the required fees to Winston & Strawn LLP Deposit Account No. 50-1814.

Respectfully submitted,

8/20/04  
Date

Allan A. Fanucci  
Allan A. Fanucci, Reg. No. 30,256

08/25/2004 EABUBAK1 00000123 501814 10798201  
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**WINSTON & STRAWN LLP**  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of: Andrew DOWNIE et al.

Confirmation No.: 6184

Application No.: 10/798,201

Group Art Unit: 3672

Filing Date: March 10, 2004

For: DOWNHOLE TOOL

Attorney Docket No.: 85170-4599

**DECLARATION IN SUPPORT OF PETITION FOR RETROACTIVE LICENSE  
UNDER 37 C.F.R. § 5.25**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Petitioner, Allan A. Fanucci, represents that he is the attorney of record for the above-identified U.S. application, filed March 10, 2004, the subject matter of which was filed abroad as U.K. Application No. GB 0101014.9 (filed January 15, 2001) and PCT Application No. PCT/GB02/00178 (filed January 15, 2002) without first obtaining a license under 37 C.F.R. § 5.11.

Petitioner states that the material for the U.K. and PCT applications was filed abroad without first obtaining a license under 37 C.F.R. § 5.11 through error and without deceptive intent. Soon after the above-identified U.S. Application was filed, Petitioner noted in a letter to the attorney of record for the U.K. and PCT applications, dated March 24, 2004, that one of the inventors resided in the United States, and asked to confirm whether this inventor's contribution to the invention was made in the United States. A copy of the letter is attached hereto.

As it has now appears that the U.S.-residing inventor's contribution may have been made in the U.S. and that a foreign filing license was not obtained prior to filing the U.K. and PCT applications, a petition for a retroactive foreign filing license is hereby submitted. The submission of the petition for a retroactive foreign filing license under 37 C.F.R. § 5.25 shows that the license is being diligently sought after discovery of the proscribed foreign filing.

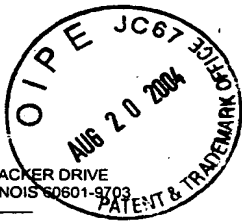
Petitioner states that the subject matter in question was not under a secrecy order at the time it was filed abroad and that it is not currently under a secrecy order.

Respectfully submitted,

8/20/04  
Date

Allan A. Fanucci  
Allan A. Fanucci, Reg. No. 30,256

**WINSTON & STRAWN LLP**  
Customer No. 28765  
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March 24, 2004

Your Ref. DM/KG/P12003US  
Our Ref.: 85170-4500  
85170-4599

Dr. David Moreland  
CRUIKSHANK & FAIRWEATHER  
19 Royal Exchange Square  
Glasgow G1 3AE  
Scotland, United Kingdom

Re: New U.S. Continuation Patent Appln of Andrew McPherson DOWNIE et al.,  
Application Serial No. 10/798,201; Filed March 10, 2004  
(corresponding to Application No. 10/619,402, Filed: July 14, 2003)  
For: IMPROVED DOWNHOLE TOOL

Dear David:

As we discussed, we have prepared and filed a Continuation application with the U.S. Patent and Trademark Office on March 10, 2004 for the above-referenced invention. A copy of the application and our filing papers are enclosed for your file.

We also simultaneously filed a Petition For Extension of Time together with a Response to Missing Parts and Payment of Retention Fee for the corresponding parent case and a copy is enclosed herewith.

Please note that we received the fax copy of the declaration signed by the first inventor Downie and will submit this upon receipt of the missing parts notice relating to the Continuation application from the U.S. Patent Office. Also, we note that one of the inventors resides in the United States. If his contribution to the invention was made in the U.S., a foreign filing license may have been required prior to the filing of the British priority or PCT applications. If this has not been done, please let us know and we will check on this. If one is needed, we can petition to obtain one retroactively.

In addition, please send us a certified copy of the priority document GB 0101014.9 at your earliest convenience for filing the U.S. Patent and Trademark Office.

NY:851900.1

# WINSTON & STRAWN LLP

Dr. David Moreland

March 24, 2004

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Finally, we remind you that all U.S. patent applicants, including the inventors and their assigns and attorneys, have a continuing obligation to disclose to the Examiner all prior art references of which they are aware which may be material to patentability of the claims. Material references include any U.S. patents or printed publications (including foreign patents) which disclose the claimed subject matter and which have an effective date which is earlier than the filing date of this application. The effective date of a U.S. patent as a prior art reference is its filing date, while for other documents, it is the publication date. Please advise whether any additional material references exist which should be submitted to the Examiner.

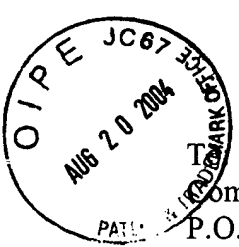
Should you have any questions regarding this matter, please let us know.

Very truly yours,



Allan A. Fanucci

Enclosures



EXPRESS MAIL LIST

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

The following items listed below are being filed herewith with the USPTO on August 20, 2004.

Express Mail No. <b>EV 346 811 5347 US</b>			
Attorney Docket No.	Appln. Serial No./ Patent No.	Items - Documents filed on <u>August 20, 2004</u>	Patent Fees- Acct. #50- 1814
85170-4599	10/798,201	Petition for Retroactive Foreign Filing License; Declaration in Support of Petition for Retroactive License; Documentary evidence in support of Declaration; and a Petition Fee of \$130 under 37 C.F.R. § 1.17(h)	\$130

*Please acknowledge receipt of these items as received by returning  
the enclosed postcards with the date of receipt of August 20, 2004.*

NY:884081.11